

REMARKS***Summary of the Amendment***

Upon entry of the above amendment, claims 1, 6, 14, and 16 will have been amended and new claims 19 - 22 will have been entered for consideration by the Examiner. Accordingly, claims 1 - 22 currently remain pending.

Summary of the Office Action

In the instant Office Action, the Examiner has objected to Figure 2 and rejected claims 6 and 14 based upon formal matters. Further, the Examiner has rejected claims 1 - 18 over the art of record. Accordingly, by the present amendment and remarks, Applicants submit that the rejections have been overcome, and respectfully request reconsideration of the outstanding Office Action and allowance of the present application.

Interview with Examiner Meislin

Applicants gratefully acknowledge the telephonic interview with Examiner Meislin on July 20, 2004, in which the Examiner confirmed that the March 30, 2004 amendment was not entered for consideration for the purposes of the instant Office Action. Further, Applicants acknowledge the Examiner's understanding that the January 30, 2004 decision from the Board of Patent Appeals and Interferences asserted that the instant invention was obvious.

Applicants, by the present amendment, have resubmitted the March 30, 2004

amendment directed to the formal matters of claims 6 and 14. However, other amendments have also been presented at this time which were not previously submitted, such as claims 1 and 16.

Further, for the reasons set forth more fully below, Applicants submit that the Examiner has misread the Board's comments. In particular, Applicants direct the Examiner's attention to page 4 of the Board's January 30, 2004 decision, in which the Board states "we are of the view that the disclosure before us is sufficiently complete such that one ordinarily skilled in the art would be able to make and use the claimed invention without undue experimentation," and to page 5 of the decision, which states "it is our view that one having ordinary skill in the wrench art would have been quite capable of combining two known wrenches to thus make the claimed motor-driven manual wrench without having to become engaged in any undue experimentation."

Applicants note that, contrary to the Examiner's interpretation, the Board is pointing out their reasons for reversing the final rejection under 35 U.S.C. § 112, first paragraph, and not making any comment regarding prior art or obviousness. Thus, Applicants submit that the Board's comments are limited to a determination that, from the disclosure, one ordinarily skilled in the art would be able to make and use the invention. Moreover, Applicants submit that, to attempt to extend the Board's holding to issues neither before the Board nor decided by the Board is wholly improper.

Traversal of Rejection Under 35 U.S.C. § 112, Second Paragraph

Applicants traverse the rejection of claims 6 and 14 under 35 U.S.C. § 112, second paragraph, as being indefinite. By the present amendment, Applicants have amended claims 6 and 14 to even more clearly recite the subject matter that the inventors regard as their invention. Therefore, claim 6 has been amended to even more clearly define the arrangement of the first torque limiter by utilizing terminology that more closely corresponds to that used in the specification. Further, new claims 19 and 20 have been presented to further define this arrangement.

Applicants note that claim 14 has been amended to more clearly recite the flat output element utilizing the terminology in the first full paragraph on page 10 of the disclosure, i.e., an element in which the bolt axis (or axis of the element being driven) does not coincide with the output tool shaft.

Accordingly, Applicants submit that claims 6 and 14 are now fully in compliance with the requirements of 35 U.S.C. § 112, and request that the Examiner acknowledge the same in the next official communication. Moreover, by the present amendment, Applicants intend to clarify certain features of claims 6 and 14 without narrowing the scope of the claims. Thus, Applicants submit that no estoppel should be deemed to attach.

Accordingly, Applicants request that the Examiner reconsider and withdraw the rejection of claims 6 and 14 under 35 U.S.C. § 112, second paragraph, and indicate that these

claims are fully in compliance with the statute.

Objection to the Drawings is Moot

Concurrently herewith, Applicants are submitting a replacement sheet of drawings that addresses and overcomes the pending drawing objection.

Accordingly, Applicants request that the Examiner consider the replacement sheet, withdraw the objection to the drawings, and indicate that the drawings are acceptable.

Traversal of Rejection Under 35 U.S.C. § 103(a)

Applicants traverse the rejection of claims 1 - 18 under 35 U.S.C. § 103(a) as being unpatentable over Applicants' Admitted Prior Art [hereinafter "AAPA"] in view of GRABOVAC (U.S. Patent No. 3,939,924). The Examiner asserts that AAPA shows that the instant invention is directed to a combination of conventional wrenches into a single inventive tool, and that the construction and operation of the individual conventional wrenches is known. The Examiner further asserts that GRABOVAC discloses combining a power operated geared wrench with a conventional torque wrench, and that it would have been obvious to combine the conventional wrenches of the AAPA into a single wrench, as taught by GRABOVAC. Applicants traverse the Examiner's assertions.

By the present amendment, Applicants' independent claim 1 recites, *inter alia*, a driving motor, a head having an output tool shaft for coupling to a driving tool, a ratchet drive located in the head, and a *handle, coupled to said head, structured and arranged to*

manually drive the ratchet drive and structured to house the driving motor.

While conventional motor driven wrenches and conventional hand-held ratchet wrenches are known in the art, Applicants note that the art of record fails to teach or suggest a combined motor driven hand-held wrench in which the handle is structured to house the driving motor. Moreover, Applicants note that GRABOVAC fails to address this defect of the prior art. In particular, Applicants note that GRABOVAC provides a driving motor appended to the outside of the wrench handle, which is contrary to the expressly recited features of the instant invention. Moreover, Applicants note that GRABOVAC fails to provide any teaching or suggestion of housing the driving motor within the handle, and certainly fails to suggest a solution whereby such a suggestion (even if provided) would even be possible.

Moreover, Applicants note that, as GRABOVAC fails to provide any teaching or suggestion of combining a hand-held and motor driven tool, in which the driving motor is housed in the handle, and even fails to provide any teaching or suggestion of housing a driving motor in the handle, the document fails to provide the requisite motivation or rationale for modifying the AAPA in the manner suggested by the Examiner.

Accordingly, Applicants submit that no proper combination of AAPA and GRABOVAC teaches or suggests the combination of features recited in at least independent claim 1.

Moreover, Applicants note that, as newly submitted claim 21 recites, *inter alia*, a handle structured to house the motor drive, no proper combination of AAPA and GRABOVAC teaches or suggests the combination of features recited in at least independent claim 21.

Still further, Applicants note that claims 7 - 12 recited features that are neither taught nor suggested by the AAPA or GRABOVAC, such as the recited display device, the recited electronic sensor, or the recited electronic circuit. As the applied art fails to teach or suggest at least the above-noted features, Applicants submit that no proper combination of these documents can render unpatentable the instant invention, such that claims 7 - 12 are separately patentable over the art of record.

Further, Applicants submit that claims 2 - 20 and 22 are allowable at least for the reason that these claims depend from allowable base claims and because these claims recite additional features that further define the present invention. In particular, Applicants submit that no proper combination of AAPA and GRABOVAC teaches or suggests, *inter alia*, the head is removably coupled to the drive motor, as recited in claim 2; an adapter which is connected to a drive shaft of the head and to an output shaft of the motor, as recited in claim 3; the head is designed as an angle head having said output tool shaft offset relative to a drive shaft of the head, as recited in claim 4; the first torque limiter is designed to be adjustable such that the transmittable tightening torque is adjustable to specified values, as recited in

claim 5; the first torque limiter comprises an articulated joint in which an articulated body is positioned between a first support and a second support, said second support being pivotably mounted for rotation around a pivot axis located at a distance from the articulated body, and said first support being positioned to rotate the second support body, whereby a limitable torque is applied to the output tool shaft, as recited in claim 6; a visual display which is activatable when a specified tightening torque is obtained, as recited in claim 7; the display is mechanically activatable, as recited in claim 8; an electrical sensor which generates a signal when a specified tightening torque is obtained, as recited in claim 9; an electronic circuit which is effectively connected to the sensor, the circuit activating at least one of an acoustic signal and a visual display when the predetermined number of driving operations implemented with a specific tightening torque is obtained, as recited in claim 10; an electronic circuit activates at least one of an acoustic signal and a visual display when a signal is received from the sensor, as recited in claim 11; the display is located at the head, as recited in claim 12; the wrench is configured as an elongate rod-type wrench, as recited in claim 13; the head further comprises a flat output element coupled to the output tool shaft, such that the output tool axis does not coincide with an axis of the element to be driven, as recited in claim 14; a wireless power supply for the motor, as recited in claim 15; the handle comprises a tubular housing accommodating the motor and an output shaft of the motor, said housing is designed with high bending strength, which bending strength during manipulation

of the wrench allows for the transmission of considerably higher tightening torques to the output tool shaft than from the motor drive, with the tubular housing having a grip area for manual actuation of the wrench, as recited in claim 16; the housing is formed of metal, as recited in claim 17; the metal is light metal, as recited in claim 18; said first and second supports are structured and arranged for movement relative to each other when the torque transmitted to the output tool shaft exceeds a limit of the limitable torque, as recited in claim 19; the relative movement between body said first and second supports is an articulating motion occurring at said articulated body, as recited in claim 20; and

Accordingly, Applicants request that the Examiner reconsider and withdraw the rejection of claims 1 - 22 under 35 U.S.C. § 103(a) and indicate that these claims are allowable over the art of record.

Application is Allowable

Thus, Applicants respectfully submit that each and every pending claim of the present invention meets the requirements for patentability under 35 U.S.C. §§ 102 and 103, and respectfully request the Examiner to indicate allowance of each and every pending claim of the present invention.

Authorization to Charge Deposit Account

The undersigned authorizes the charging of any necessary fees, including any extensions of time fees required to place the application in condition for allowance by

Examiner's Amendment, to Deposit Account No. 19 - 0089 in order to maintain pendency of this application.

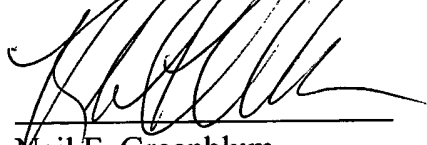
CONCLUSION

In view of the foregoing, it is submitted that each of claims 1 - 22 are allowable. In particular, the claims have been amended to eliminate any arguable basis for rejection under 35 U.S.C. § 112, and each claim is patentable over the art of record.

Further, any amendments to the claims which have been made in this response and which have not been specifically noted to overcome a rejection based upon the prior art, should be considered to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to attach thereto.

Accordingly, reconsideration of the outstanding Office Action and allowance of the present application and all the claims therein are respectfully requested and now believed to be appropriate.

Respectfully submitted,
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